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of the Office Action.

With regard to the rejections under 35 U.S.C. §112, second paragraph, the Examiner states that claim 10 is indefinite in that "at least 120 minutes" does not recite a "maximum bound." However, Applicant cannot see why a maximum bound is necessary, since 120 minutes or less constitutes a reasonable limitation at least with respect to this claim. Perhaps the Examiner could explain why this recitation is indefinite.

With regard to claim 12, the Examiner is correct in that "program" makes reference to the audio/video program of claim 1, and claim 12 has been amended accordingly. Claim 14 includes the language of "means to convert the input program into a 24 frames-per-second (fps) format, if necessary ..."(emphasis added). The Examiner states that this is indefinite, asking what happens if it is not necessary. In reply, the Applicant states that if the input program is already in a 24 fps production format, conversion would not be necessary. That is the reason for this language. If the Examiner can suggest a more appropriate way of wording this, the Examiner is invited to do so.

Claims 1-28 stand rejected under 35 U.S.C. §102(e) as being anticipated by Washino et al, U.S. Patent No. 5,537,157. Such rejection is clearly inappropriate. The instant application, Serial No. 08/834,912, adds new matter relative to the issued '157 patent, and Applicant is clearly entitled to claims directed to that new matter, even if presented in combination. Whoever invents or discovers any new and useful process, machine ... or any new and

useful improvement thereof, may obtain a patent therefore ... (35 U.S.C. §101, emphasis added).

The present disclosure and claims represent an improvement over the subject matter set forth the '157 patent, and Applicant is entitled to a patent on those improvements. It is well settled that in order to anticipate, a prior-art reference must disclose each and every element of a claimed invention under 35 U.S.C. §102. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In this case, the issued '157 patent clearly does not disclose each and every element of the instant invention as claimed, and for that reason, rejection under §102 of the Statute cannot be sustained.

In particular, the instant application contains 28 claims, of which claims 1, 14 and 18 are independent. Claim 1 includes the limitation of a high-capacity video storage means including an asynchronous program recording and reproducing capability, enabling the user to perform, among other functions, a frame-rate conversion of a program received through the input. Claim 14 has been amended with certain limitations from claim 16, which has been canceled, and now sets forth the use of high-capacity video storage means having a synchronous recording/reproducing capabilities to effectuate a speed-up of frame rate from an internal format of 24 frames per second to a frame rate in excess of that, such as 25 fps or 30 fps. Claim 18 also includes the step of providing a high-capacity video storage means equipped with an asynchronous program recording and reproducing capability to perform a frame rate conversion. As explained in

further detail below, this subject matter is neither set forth explicitly nor fairly suggested by the teachings of the '157 patent.

The use of this asynchronous capability as disclosed and claimed in the instant invention provides an improvement over the teachings of the '157 patent, in that conversions from 25 fps to 24 fps or 30 fps, which require a slow-down process, are now readily accommodated, as is the conversion of an internal format of 24 fps to an output of 25 fps. Although the problems associated with such conversions are set forth in the '157 patent, a suitable solution to the problem is not. This is largely due to the fact that the system contemplated by the '157 patent uses a 24 fps internal format so as to be compatible with film, as opposed to a 25 fps format which would be compatible with the PAL standard, which is not as universally accepted.

Although the conversion of the internal 24 fps format to an external 25 fps format is addressed by the '157 patent, conversions of a 25 fps internal format to 24 and 30 fps format are not. Moreover, with respect to the 24 fps-to-25 fps conversion, it is noted at column 14, lines 8-14 of the '157 patent that a suitable solution to this problem was not recognized prior to the invention of the instant application. In particular, the passage reads, in pertinent part:

> "In this case more sophisticated frame-rate conversion techniques may be required for viewing live broadcasts, since the 24 fps input signal rate cannot keep pace with the 25 fps display rate. However, in practice it is anticipated that future television sets will incorporate "multi-sync" designs that eliminate this potential problem."

From this, it is clear that the inventors did not have, in their possession, the knowledge to implement these "slow down" techniques in particular and, in fact, teach away from the presently disclosed technique through a reliance on "multi-sync" designs to eliminate the "potential problem."

Based upon the foregoing, Applicant believes all claims distinguish over the '157 patent, and are therefore allowable under §102 of the Statute. Questions regarding this application should be directed to the undersigned attorney at the telephone and facsimile numbers provided.

Respectfully submitted,

By: _____

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